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Paper No. 9

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**COPY MAILED**

**MAR 22 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Thomas Joseph Boyle :  
Application No. 09/989,783 : ON PETITION  
Filed: 20 November, 2001 :  
Attorney Docket No. 05235.00002 :

This is a decision on the petition requesting revival of the above-identified application, filed on 1 March, 2005, which, in the absence of the proper fee, is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.<sup>1</sup>

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181" or as described within, under 37 CFR 1.137(a) or (b). This is not a final agency action.

This application became abandoned on 14 April, 2003, for failure to timely reply to the non-final Office action mailed on 13 January, 2003, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 24 September, 2003.

In the absence of the proper petition fee, which is required by law, the PTO can only treat the instant petition as a (feeless 1.181) petition to withdraw the holding of abandonment.<sup>2</sup> The PTO

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<sup>1</sup>In the absence of the petition fee, which is required by law, the PTO can only treat the instant petition as a (feeless 1.181) petition to withdraw the holding of abandonment. See Krahn v. Comm'r, 15 USPQ2d 1823, 1825 (E.D. Va. 1990).

<sup>2</sup>See Krahn v. Comm'r, 15 USPQ2d 1823; 1825 (E.D. Va. 1990).

will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.<sup>3</sup> While petitioner submitted \$55.00 for the petition fee, effective 8 December, 2004, the fee for a petition under 37 CFR 1.137(a) (small entity) was \$250.00. In order to receive consideration under 37 CFR 1.137(a), the balance due of \$195.00 must be submitted.

Petitioner asserts that the non-final Office action mailed on 24 September, 2003, was never received. A review of the written record indicates no irregularity in the mailing of the Notice, and in the absence of any irregularity there is a strong presumption that the Notice was properly mailed to the applicant at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.<sup>4</sup> This showing may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail.

Petitioner asserts that the Office action mailed on 24 September, 2003, was not mailed to petitioner's current address. Specifically, petitioner asserts that a Change of Correspondence Address was filed with an Information Disclosure Statement on 20 February, 2002, but that the Change of Correspondence Address was never entered. A copy of the Change of Correspondence Address asserted to have been filed on 20 February, 2002, is included with the present petition. Petitioner further asserts that in other cases which had been transferred from Banner & Witcoff to the new correspondence address, the prior attorneys had forwarded copies of Office actions to petitioner at the current address.

A review of the official file reveals that an Information Disclosure Statement was filed on 20 February, 2002. However, no Change of Correspondence Address is located among the papers

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<sup>3</sup>MPEP 711.03(c); see 35 U.S.C. 41(a)(7).

<sup>4</sup>See Withdrawing the Holding of Abandonment When Office Actions Are Not Received; Notice 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

received on 20 February, 2002. Moreover, the copy of the Change of Correspondence Address supplied with the present petition reveals that no Certificate of Mailing or Transmission in accordance with 37 CFR 1.8 is included thereon. As such, there is no way to verify that a Change of Correspondence Address was in fact filed on 20 February, 2002, or on any date prior to the mailing of the non-final Office action mailed on 13 January, 2003.

With regard to petitioner's contention that the previous attorneys of record would forward correspondence to petitioner's counsel's current address, petitioner's must provide evidence that either (a) petitioner's was receiving mail at the correspondence address of record at the time the Notices were mailed or (b) petitioner notified the PTO of a change in the correspondence address prior to the mailing of the Notices.

MPEP 601.03 requires an attorney or agent of record to promptly notify the Patent and Trademark Office of a change in the correspondence address. The required notification need take no particular form, but must be provided in a manner calling attention to the fact that a change of address is being made. Petitioner failed to timely inform the Office of the address change. Failure by counsel to act properly cannot represent Office error and therefore cannot serve as a basis for withdrawal of the holding of abandonment.

In summary, a review of the record points to the conclusion that the Notice was not received due to petitioner's failure to inform the PTO of a change in the correspondence address. As such, withdrawal of the holding of abandonment is not proper. Specifically, no change of correspondence address was filed prior to the mailing of the non-final Office action mailed on 13 January, 2003. As such, the Office action was mailed to the proper address. As no reply was received, the application did become abandoned for failure to timely reply to the non-final Office action mailed on 13 January, 2003.

If petitioner has evidence showing that the change of correspondence address was filed on 20 February, 2002 (i.e., an itemized postcard receipt stamped by the USPTO or a transmittal letter itemizing the filing of the Change of Correspondence Address bearing a timely certificate of mailing), petitioners may wish to file such evidence with a renewed petition.

**REQUIRED REPLY**

Petitioner has not submitted a reply to the Office action mailed on 13 January, 2003. In order for the application to be revived as described below, the required reply to the Notice must be submitted with any petition to revive. A courtesy copy of the Office action is sent as an attachment to this decision for assistance in preparing petitioner's reply.

#### **ALTERNATE VENUE**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner

intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

Receipt of the revocation and power of attorney and change of correspondence address filed with the present petition is acknowledged. While the correspondence address has been changed, according to Office Customer Number records, no practitioners are associated with Customer Number 32159. As such, no attorneys have been appointed in this application. Should petitioners wish to appoint a registered patent attorney, a new power of attorney listing the practitioner or a Customer Number with which the practitioner is associated must be filed.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450

By FAX:           (703) 872-9306  
                  Attn: Office of Petitions

By hand:          Customer Service Window  
                  Mail Stop Petition  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



Douglas I. Wood  
Senior Petitions Examiner  
Office of Petitions

Enclosure:       PTO/SB/64  
                  Office Action mailed 31 January, 2003  
                  Notice Regarding Change of Power of Attorney  
                  Privacy Act Notification